

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Massague et al.

Serial No: 09/865,018

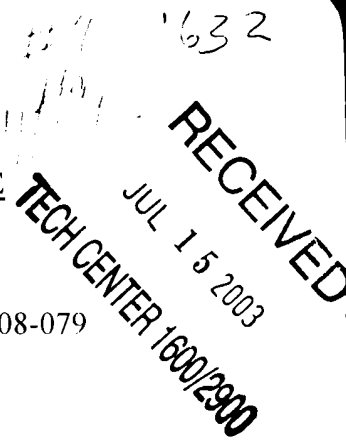
Filed: May 24, 2001

For: Isolated p27 Protein and Methods for
Its Production and Use

Attorney Docket No. GPCI-P08-079

Art Unit: 1632

Examiner: Shin-Lin Chen

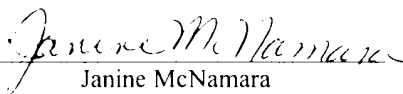


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Janine McNamara

Commissioner for Patents
PO Box 1450
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REPLY TO OFFICE COMMUNICATION

Sir:

The Office Communication mailed June 13, 2003, in connection with the above application, acknowledges Applicants' election of Group VI (claims 32-35) in Paper No. 10. The Examiner also acknowledges the addition of claims 36-47.

In reply to the species election requirement in the Office Communication, Applicants hereby elect with traverse human p27 amino acid sequence as set forth in SEQ ID No. 2, as a single SEQ ID No. Applicants traverse the species election since the species subjected to election are encompassed by Markush groups. Pursuant to MPEP 803.02, "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to

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non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02). In this case, it is Applicants' position that the members of the Markush group are "sufficiently few in number" and may be searched and examined without a serious burden on the Examiner.

Furthermore, Applicants note that MPEP § 803.04 states that "to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application." The MPEP goes on to state that "it has been determined that normally ten sequences constitute a reasonable number for examination purposes." Once again, Applicants submit that the present claims include less than 10 sequences and as such constitute a reasonable number of sequences for search and examination.


Accordingly, Applicants respectfully request reconsideration and withdrawal of the single sequence election requirement and request a search and examination of all three p27 amino acid sequences claimed herein.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: July 7, 2003

Customer No: 28120
Patent Group LLP
Ropes & Gray
One International Place
Boston, MA 02110
Phone: 617-951-7000
Fax: 617-951-7050



David P. Halstead
Reg. No. 44,735